REMARKS

Reconsideration is respectfully requested for Claims 31-41, said claims having been variously rejected as follows:

Claim 41 has been rejected under 35 U.S.C. 112 as being indefinite. The Office Action states that it is not clear how mounting the external seal on a sliding sleeve provides an actuator and, as per the language of claim 41, engagement of the seal with the casing during insertion opens the valve. Applicants submit that this mounting of the external seal on a sliding sleeve is a highly unique means of providing an actuator for opening the valve as the tool is inserted into the casing so that the tool is immediately available for operation.

Although tool operation is explained in complete detail in the specification, Applicants provide here a brief explanation of the operation of the seal/sliding sleeve actuator component for the convenience of the Examiner. Referring to Fig. 3A, it will be apparent that sliding sleeve 26 covers ports 19c thereby preventing fluid flow. When sliding sleeve 26 moves upwardly as shown in FIG.4, then ports 19c are uncovered to permit fluid flow. Thus, the sliding sleeve 26 and ports 19c form at least a portion of a valve. See attached definition whereby a "valve" is a device that, inter alia, controls movement of liquids by opening or closing ports. Further, it will be understood that spring 25 biases sliding sleeve 26 in the valve closed position by biasing sleeve 26 to cover ports 19c. Thus, when the tool is removed from the casing, the ports 19c are automatically covered by sleeve 26. It is plainly apparent that seal 30 is mounted to sliding sleeve 26. During operation, and referring now to FIG. 4, as the tool is inserted into casing 32, the friction of engagement of seal 29 (at engagement points 29b) limits the downward movement of sleeve 26. Therefore, as the tool is moved into the casing, sleeve 26 moves upwardly on the tool body overcoming the force of biasing spring 26 to thereby uncover ports 19c, so as to actuate the valve from the closed position to the open position. The result is that the tool is ready to circulate fluid through the wellbore immediately upon being inserted into the casing, which

is an advantage. As discussed above, when the tool is withdrawn from the casing, then the friction of removal, and/or spring 25, will cause sliding sleeve 26 to cover ports 19c. See also p. 22, line 21 - p 23, line 5 of the applicants' specification. Accordingly, it is respectfully submitted that the rejection under 35 U.S.C. 112 is traversed because one of ordinary skill in the art, upon reading the specification, will understand that mounting the seal on the sliding sleeve produces a unique actuator that automatically opens the valve as the tool is inserted into the casing. With respect to listing the appropriate law, Applicants respectfully note that to support the rejection, the Examiner bears the burden of proof of showing that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. *Ex parte Wu,* 10 USPQ 2d 2031, 2033 (B.P.A.I. 1989).

In fact, the inventor of USPN 6,173,777, who is very familiar with operation of the tool described in this present application, copied a basic concept of the applicants' operation and now even goes so far as to broadly claim the invention of the present concept of a fill-up and circulation tool with a valve/actuator, as his own property, that opens upon insertion into the casing so as to be immediately available for operation.

Claims 31-41 have been rejected under 35 U.S.C. 112 as containing subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the art that the present inventors had possession of the claimed invention.

More specifically, the Office Action states (1) that <u>all</u> of claims 31-41 call for a valve in the internal passage and (2) that Applicant does not have a valve "in" the internal passageway.

Applicants respectfully submit that neither of the above assertions (1) or (2) are correct.

With respect to item (1), it is stated that all claims call for a valve "in" the passageway. In fact, Claims 34, 37, and 40, each call for a valve "for" the internal passage. Without even considering the

other valve components as discussed hereinafter, clearly the sliding sleeve 26 and ports 19c operate to affect fluid flow "for" the internal passage and therefore clearly are "for" the internal passage with no requirement that the valve must be "in" the internal passage. Claim 36 simply calls for first and second valves to control flow through first and second ports with no requirement for location of the valve. Thus, these claims more broadly cover the concept of any valve "for" the passageway without specifying the particular location thereof whether "in" "out" or "remote therefrom." Accordingly, even though Applicants respectfully submit that the valve contains elements "in" the internal passageway as discussed below, and even assuming that the sliding sleeve and ports are "outside" the internal passageway (no admission is implied or given), then Applicants respectfully submit that the rejection is nonetheless traversed with respect to claims 34-41.

With respect to item (2) above, wherein the Office Action states that Applicants do not show a valve "in" the internal passage, Applicants respectfully submit that this is clearly incorrect. It is first noted that a valve is typically much more than relatively moveable elements such as the control elements, e.g., the ball/handle in a ball valve. For instance, a handle attached to a ball in thin air is not a valve because it does not on its own control fluid flow. There must be other supporting elements, which may or may not be moving components, to contain or direct the fluid flow and which cooperate with the control elements to control fluid flow and thereby form a valve. For instance, a typical valve comprises a housing. With respect to the sliding sleeve valve plainly disclosed by Applicants' specification, there must be some means that limits fluid flow in the internal passageway. Otherwise, the covering and uncovering of ports 19c by sliding sleeve 26 would have no effect of controlling fluid flow and therefore would not comprise a valve.

While plunger 40, which is listed in the preliminary amendment as being part of the valve, is perhaps the main means for limiting fluid flow in the internal passageway 19a, choke 37 and plunger seat 43a also plainly limit fluid flow through internal passageway 19a. However, referring simply to

plunger 40, when sliding sleeve 26 covers ports 19c, then plunger 40 completely controls fluid flow through internal passageway 19a. Once sliding sleeve 26 opens to permit fluid flow through ports 19c, then plunger 40 may or may not be in the open position depending on whether the pressure differential between inside the internal passageway 19a and the bottom of the tool is sufficient to overcome the bias force acting on plunger 40 due to plunger spring 39. At any rate, it is clear that plunger 40 cooperates with sliding sleeve 26/ports 19c to thereby direct some or all fluid from internal passageway 19a through ports 19c when sliding sleeve 26 is in the open position. It is also clear that plunger 40, as well as other components, are "in" the internal passage. Accordingly, Applicants respectfully submit that the rejection is also traversed with respect to Claims 31-33.

In summary, Applicants submit that the rejections are traversed and that claims 31-41 are in condition for allowance. Moreover, Applicants submit that Claims 38-41 are in prima facia condition for provoking an interference with one or more claims in U.S. Patent No. 5, 971,079 as previously requested.

Respectfully submitted,

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